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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/933,715

08/22/2001

Hideaki Takahashi

SON-2200

6288

23353 7590 06/26/2008  
RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/933,715	<b>Applicant(s)</b> TAKAHASHI ET AL.	
	<b>Examiner</b> Daniel Kesack	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2008 has been entered.

### ***Status of Claims***

2. Claims 1-7, 9-12, and 15-17 are currently pending. The rejections are as stated below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-7, 9-12, and 15-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by “virtual world” and “real world”. Examiner considers any Internet or electronic transaction to be a virtual world transaction, because the transaction takes place in the “virtual world” of the internet or network interconnections, as well as a "real world" transaction because the transaction is taking place in the real world. Examiner considers any transaction both a virtual world and a real world transaction. A cash transaction is the only transaction Examiner considers to be entirely and definitely “real world”. Furthermore, it is not clear how an IC card can even exist in “virtual world” (i.e., a world that is not real). Since there is no clear distinction between a transaction taking place in a virtual world and a transaction taking place in a real world, the claims are indefinite.

Furthermore, claim 4 is considered indefinite because it does not further limit claim 1, from which it depends. Claim 1 describes the information is “automatically converted... when the user conducts transactions”. Claim 4 recites the information is converted in response to a request from the user. It is not clear how the conversion can take place both automatically and upon a user request.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-7, 9-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel et al., U.S. Patent No. 6,594,640, in view of the Wall Street Journal article "Takeoffs & Landings", by Danielle Reed and Michelle Higgins, hereinafter *Reed*, and further in view of Chen, U.S. Patent No. 6,549,912.

Claims 1, 11, Postrel teaches a communications system and method comprising:

a first management apparatus for managing and settling a first transaction (column 3 lines 5-12: user conducts a transaction with a related system), and generating first privilege information generated in accordance with the first transaction conducted between the first management apparatus and a user ("accumulate value on

the partner's system), using a user identifier that identifies the user in such a manner that the first privilege information and the user identifier are correlated with each other (inherent, because user is required to enter frequent flyer account number into the related system);

a second management apparatus for managing and settling a second transaction (column 5 lines 17-20, and figure 1: user conducts transactions with any system associated with airline 1), and generating a second privilege information that is generated in accordance with the second transaction conducted between the second management apparatus and the user (user conducts e-commerce transactions, information is managed by reward servers – column 5 lines 17-36), and using the user identifier in such a manner that the second privilege information and the user identifier are correlated with each other (column 3 lines 2-10, user has a frequent flyer account number, which identifies user's frequent flyer miles in the system of airline 1) and wherein the second transaction includes a settlement processing based on the user identifier and a price (user accumulates frequent flyer points for the user's frequent flyer account number based on the transaction);

wherein the second management apparatus converts the first privilege information that is managed by the first management apparatus into privilege information to be managed by the second management apparatus and manages the privilege information, such that the privilege information is automatically converted to the second privilege information and added to a total of the second privilege information for the user when the user conducts transactions (figure 3 and column 3 lines 5-10).

Postrel fails to teach the privilege information being converted according to a prescribed conversion factor.

Reed teaches converting points from a hotel chain into frequent flyer miles according to a prescribed conversion factor (page 1, last paragraph). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the combine the teachings of Postrel and Reed because both Postrel and Reed describes a reward system involving multiple entities and converting reward points.

Postrel fails to teach the identifier is stored in an IC card.

Chen discloses a loyalty file structure for smart cards wherein user identification information relating to a loyalty program is stored on a smart card (figures 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel and Reed to include storing identification information of the frequent flyer account on a smart card because the environment in which Chen implements the disclosed invention is identical to the operational environment of Postrel and Reed (Postrel discloses the use of the system with a smart card – column 9 lines 55-67), and the smart card identification of Chen provides a convenient way for a card holder to identify himself or herself, and convenience is a desirable feature in the current invention.

Claims 2, 3, 5, 12, 15, Postrel teaches the first and second privilege information are addable point (column 6 lines 37-40), are both rewards information, and describe how much the user is able to redeem, and which is redeemable for service (column 1 lines 13-15).

Claim 4, Postrel teaches the conversion of privilege information taking place in response to a request from the user (column 4 lines 6-11).

Claim 6, Postrel teaches the second management apparatus performing settlement processing in response to a settlement request about a transaction that the user has conducted (column 7 lines 31-41).

Claim 7, Postrel teaches the second management apparatus performs the processing of issuing the point (column 5 lines 11-20).

Claims 9, 16, Postrel teaches the first management apparatus providing the privilege information in accordance with a contribution by the user in the virtual world (user makes a purchase, and points are provided to the user through the reward server – column 5 lines 17-36).

Claims 10, 17, Postrel teaches the second management apparatus providing the privilege information in accordance with a credibility of the user (column 6 lines 1-7).



### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 11 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack

June 21, 2008

/D. K./

Examiner, Art Unit 3691

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691